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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,240	01/16/2004	Jochen Antel	029300.52994US	5312

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CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON, DC 20044-4300

EXAMINER

WITHERSPOON, SIKARL A

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/758,240	ANTEL ET AL.	
	Examiner	Art Unit	
	Sikarl A. Witherspoon	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-15 and 27-32 is/are allowed.
- 6) ☒ Claim(s) 1,8,10,11,16 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1 and 2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Bonnet-Delpon et al (J. Org. Chem. 1988).

Compound 4c on page 754 of the reference anticipates the instant claim.

Claims 16 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Cailly et al (EP 0289390).

The compound disclosed on the top of page 4, having the formula $C_{12}H_{25}-C_6H_4-CO-CH_2-CO-CF_3$, anticipates the instant claims.

Claims 16 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Eidenschink et al (US 4,297,515).

The reference discloses the compound, 1-[4-(4-methylcyclohexyl)-phenyl]-4,4,4-trifluorobutane-1,3-dione (col. 9, line 33). This compound anticipates the instant claims.

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Ghomashchi et al (Biochimica et Biophysica Acta 1420 (1999)).

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The reference discloses a trifluoromethyl ketone of the formula $\text{Ph}(\text{CH}_2)_4\text{COF}_3$ being employed to inhibit human groups IV and VI phospholipases (abstract). The instant claim is therefore anticipated by Ghomashchi et al.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11, although not anticipated is rejected under 35 U.S.C. 103(a) as being unpatentable over Ghomashchi et al. and further in view of Johnson et al (US 4,917,826).

The instant claim limits the method specifically to pancreatic lipase. Ghomashchi et al does not *expressly* teach that the phospholipases that are inhibited in their process are of pancreatic origin. However, Johnson et al teach that phospholipases, such as PLA_2 are found in the pancreas (specifically a hog pancreas).

The instant claim is therefore rendered obvious over Ghomashchi, in view of Johnson et al, since Johnson et al teach that phospholipase enzymes are found in the pancreas.

Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ghomashchi et al and Johnson et al in combination.

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The instant claims are drawn to a method of treating or inhibiting obesity, metabolic syndrome, hypotension, insulin resistance, etc., by administering to a mammal in need, a trifluoromethyl ketone compound of formula (I).

Ghomashchi et al teach the inhibition of human groups IV and VI phospholipases using a trifluoromethyl ketone of the formula, $\text{Ph}(\text{CH}_2)_4\text{COF}_3$, but, does not teach the treatment or inhibition of said conditions. However, Johnson et al teach that conditions such as diabetes and obesity can be treated by inhibiting phospholipase A₂ (abstract, col. 7, line 65 to col. 8, line 63).

It therefore would have been obvious to a person of ordinary skill in the art to combine the teaching of Ghomashchi with that of Johnson et al. A person of ordinary skill would have been motivated to combine such teachings by the desire to obtain other compounds (in this case, trifluoromethyl ketones) that are known to have an inhibitory effect on phospholipase, so as to broaden the possible treatment options for phospholipase mediated conditions.

Allowable Subject Matter

Claims 2-7, 9, 12, 17-24, and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: claims 13, 14, and 15 are drawn to compounds not taught or suggested by the

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closest prior art of record. Claims 28-32 are drawn to a process for preparing trifluoromethyl ketones of formula (I'). The closest prior art of record fails to teach or fairly suggest the reaction of a carboxylic acid of formula (Xib') with an acetic anhydride, and reacting the cyclic En-lactones formed as intermediates, with (trifluoromethyl)trimethylsilane, as claimed herein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sikarl A. Witherspoon whose telephone number is 571-272-0649. The examiner can normally be reached on M-F 8:30-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sikarl A. Witherspoon 9/17/04

Sikarl A. Witherspoon
Patent Examiner
Technology Center 1600